

06-17-05

JFW



Express Mail  
ER 525323924 US

JAMES F. BAIRD  
ATTORNEY AT LAW  
33 East Main Street-On the Common  
P O Box 574  
West Brookfield, Massachusetts 01585-0574

(508) 867-2441  
(888) 867-2441

FAX:(508) 867-2441

June 16, 2005

Commissioner For Patents  
POBox 1450  
Alexandria, Virginia 22313-1450

Re: Title: GOLF CLUBHEAD MARKINGS, METHODS AND TOOLS  
Application No.: 10/692,517  
Filing Date: 10/24/2003  
Inventor's Name: BERNARD J. PATSKY  
Attorney's Docket No.: UTL 03-032

Gentlemen:

Enclosed please find Response to Office Action mailed March 16, 2005.

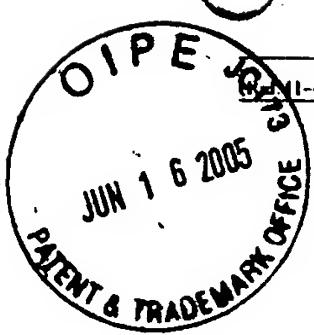
Also enclosed please find a self addressed postcard. Please indicate the date the Response is received on the card and return same to the undersigned.

If you have any questions, please call.

Very truly yours,

  
James F. Baird, Esq.  
Reg. No. 31,463

JFB/



Express Mail  
ER 525323924 US

**PATENT**

Atty. Doc. No. UTL 03-032

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Bernard J. Patsky

Serial No.: 10 / 692,517

Group No.:

Filed: 10/24/2003

Examiner: Blau, S

For: Golf Clubhead Markings, Methods and Tools

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**AMENDMENT TRANSMITTAL**

1. Transmitted herewith is an amendment for this application.

**STATUS**

2. Applicant is

- a small entity — verified statement:  
 attached.  
 already filed.  
 other than a small entity.

**CERTIFICATION UNDER 37 CFR 1.10**

I hereby certify that this amendment transmittal and the documents referred to as enclosed therin are being deposited with the United States Postal Service on this date June 16, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number ER 525323924US addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

JAMES F. BAIRD

(Type or print name of person mailing paper)

(Signature of person mailing paper)

NOTE: Each paper or fee referred to as enclosed herein has the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 CFR 1.10(b).

## EXTENSION OF TERM

**NOTE:** "Extension of Time In Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period. If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

**NOTE:** See 37 CFR 1.645 for extensions of time in interference proceedings and 37 CFR 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply

*(complete (a) or (b) as applicable)*

(a)  Applicant petitions for an extension of time for the total number of months checked below:

<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input type="checkbox"/> one month	.00	.00
<input type="checkbox"/> two months	.00	.00
<input type="checkbox"/> three months	.00	.00
<input type="checkbox"/> four months	.00	.00
		Fee \$ <u>0.00</u>

If an additional extension of time is required please consider this a petition therefor.

*(check and complete the next item, if applicable)*

An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

OR

(b)  Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

## FEE FOR CLAIMS

4. The fee for claims has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY	OTHER THAN A SMALL ENTITY
CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE
TOTAL •	MINUS ••	=	x6= \$	x12= \$ 0.00
INDEP. •	MINUS •••	=	x17= \$	x34= \$ 0.00
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM			+55= \$	+110= \$ 0.00
			TOTAL \$	OR TOTAL \$ 0.00
			ADDIT. FEE \$	

- If the entry in Col. 1 is less than entry in Col. 2, write "0" in Col. 3.
  - If the "Highest No. Previously Paid for" IN THIS SPACE is less than 20, enter "20".
  - If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
- The "Highest No. Previously Paid For" (Total or indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

*(complete (c) or (d) as applicable)*

- (c)  No additional fee for claims is required

OR

- (d)  Total additional fee for claims required \$\_\_\_\_\_

## FEE PAYMENT

5.  Attached is a check in the sum of \$\_\_\_\_\_.
- Charge Account No. \_\_\_\_\_ the sum of \$\_\_\_\_\_.

A duplicate of this transmittal is attached.

## FEE DEFICIENCY

**NOTE:** If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

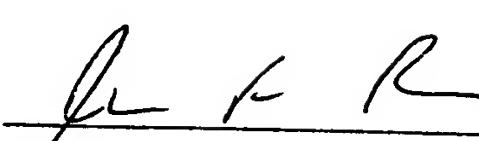
6.  If any additional extension and/or fee is required charge Account No. \_\_\_\_\_

AND/OR

If any additional fee for claims is required, charge Account No. \_\_\_\_\_

Reg. No.: 31,463

Tel. No.: (508) 867-2441

  
\_\_\_\_\_  
SIGNATURE OF ATTORNEY

James F. Baird

Type or print name of attorney

P.O. Box 574

P.O. Address

West Brookfield, MA 01585-0574



Express Mail  
ER 525323924 US

**PATENT**

Atty Doc No UTL 03-032

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Bernard J. Patsky

Serial No.: 10/692,517

Group No.:

Filed: 10/24/2003

Examiner: Blau, S.

For: Golf Clubhead Markings, Methods and Tools

**Commissioner of Patents and Trademarks****Washington, D.C. 20231** ACTION**RESPONSE TO OFFICE**MAILED Mar 16, 2005 19 LETTER

**WARNING:** "Submission of the appropriate extension fee under 37 C.F.R. 1.136(a) is to no avail unless a request or petition for extension is filed." (Emphasis added) Notice of November 5, 1985 (1060 O.G. 27).

Examiner:

Enclosed please find response to your Office Action  
mailed March 16, 2005, consisting of five (5) pages.

**CERTIFICATION UNDER 37 CFR 1.10****Response to Office Action**

I hereby certify that this ~~now transmitted~~ Response to Office Action and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date June 16, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number ER 525323924 US addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

JAMES F. BAIRD

(Type or print name of person mailing paper)

(Signature of person mailing paper)

**NOTE:** Each paper or fee referred to as enclosed herein has the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 CFR 1.10(v).

EXPRESS MAIL  
ER 525323924 US

Examiner:

In response to the office action of March 16, 2005, please accept the following:

**For entry in the case:**

- a. (1-2) **Amend Claim 4 by deleting “may”, at line 1, and add “is able to” in place thereof.**

It is requested that this amendment be entered in the case. Claim 4 is amended by deleting the term “may” at line 1. and substituting “is able to” in place thereof. A revised Claim List is enclosed, in addition a marked up version of Claim 4 is provided indicating portions added, being underlined, and portions deleted, being within brackets, red marking is used in the right margin at the changes. The Examiner felt that the term “may” was indefinite. No new matter is included.

- b. (1-2) **Amend Claim 17 by deleting “may”, at line 2, and add “is able to” in place thereof.**

It is requested that this amendment be entered in the case. Claim 17 is amended by deleting the term “may” at line 2. and substituting “is able to” in place thereof. A revised Claim List is enclosed, in addition a marked up version of Claim 17 is provided indicating portions added, being underlined, and portions deleted, being within brackets, red marking is used in the right margin at the changes. The Examiner felt that the term “may” was indefinite. No new matter is included..

- c. (3-5) **No Response Required.**

- d. **Remarks and Discussion.**

The applicant has removed the word “May” from Claims 4 and 17 and inserted the phrase “is able to” in place thereof. No new matter is included. Reconsideration of your office action is requested.

**d. (6-9) Discussion and Response regarding 35 USC 103(a) rejection.**

The Examiner cited 35 USC 103(a) as forming the basis for an Obviousness rejection. For the reasons set forth below the Applicant respectfully disagrees with the Examiner. The Examiner rejected Claims 3,4,5 and 17 pursuant to 35 USC 103(a) as being unpatentable over Ryan in view of Jessen and Kobayashi.

The Examiner stated that Ryan “discloses golf club with a parallax corrected sweet spot markings, a marking extending from a point at the intersection of the face surface and top surface, and a reference line on a drawing showing non-corrected target lines and corrected lines. The Examiner states that Ryan does not disclose markings on a head for a non-corrected target marking. The Examiner references Ryan’s Abstract, Col. 1, Lns. 19-25, and Figures 2, 3, and 5.

The Examiner appears to agree with the Applicant that Ryan does not show lines that appear on the golf club but rather only shows drawing lines.

Ryan clearly states that his sight line device takes into account two factors that affect the player’s ability to have the desired point on the club head face make contact with the ball at impact. Namely downward bowing and golfer’s visual parallax error. Ryan uses two markings i.e. Impact Marker, situated on the clubhead striking surface, to compensate for the error created by bowing of the shaft during forward swing, and Sight Line Device, situated on the top surface of the clubhead with a forward end at the forward edge line formed by the intersection of

the clubhead top surface and said clubhead striking surface, to compensate for the error created by the players sight line or parallax error.

Ryan physically locates what he considers to be the impact center 6, not based upon the actual balance point, but rather based upon what he considers to be the geometric center of the Clubface, to 6B to correct for the bowing of the shaft during a dynamic swing state, thereafter 6B is used to derive and locate the Sight Line Device, based upon the line of sight parallax correction. The present invention does not consider shaft bowing during either a static or dynamic swing state. The present invention markings are derived from a balance point on the Club Head face surface at a static state.

Ryan applies his corrections in two steps, first for a dynamic situation where the impact marker is relocated on the clubhead face from a static position to a dynamic position for when the golf club is in motion during the downward swing causing bowing, or bowing error, of the shaft. Ryan then relocates his Sight Line Device for the Parallax error. The Examiner does not agree that this combined correction makes Ryan distinguished from the Applicants invention. Without belaboring the point there is a difference. The present invention claims markings on the clubhead that are derived from a static condition after finding the balance point on the face of the club head component. The point of balance is never moved, for any reason, bowing or otherwise, but remains as a constant point of reference.

The present invention has a Parallax Corrected Sweet Spot Target Line as claimed in Claim 3, Incorrect Sweet Spot Target Line and Parallax Corrected Sweet Spot Target Line as claimed in Claim 4, Incorrect Sweet Spot Target Line and Parallax Corrected Sweet Spot Target Line as claimed in Claim 5 and Incorrect Sweet Spot Target Line, Parallax Corrected Sweet

Spot Target Line and Face Line as claimed in Claim 17. All of the foregoing referenced lines are on the Clubhead Top Surface. Ryan does not have any lines on the top surface.

Jessen is not a Golf Club invention. Jessen titles the invention GOLF INSTRUCTION DEVICE and states that the invention relates to educational devices, and more particularly to instruction means for golf. The Claims of Jessen state that what is claimed is A GOLF INSTRUCTION DEVICE, not a golf club. The markings in Jessen are not claimed or disclosed as being on a golf club.

Kobayashi discloses a golf club head body with a face and a backside. Kobayashi never uses the terms top surface or bottom surface. Further Kobayashi never identifies an intersection of a top surface with a bottom surface. The Applicant feels that the use of Kobayashi as an example of prior art indicating an intersection of a top surface with a bottom surface is improper. The Examiner disagrees with this argument stating that figure 2 in Kobayashi shows a top surface intersecting with a bottom surface. The Applicant believes that this observation is inaccurate as Kobayashi only discloses two surfaces, namely a face and a sole plate. In the Claims Kobayashi claims a golf club head with a front surface where he locates a face plate with a face. Kobayashi also claims a sole plate which is located at the bottom of the golf club head. Kobayashi makes use of the term backside as being in one case the backside of the face plate and in the other as the backside of the head body. It appears that Kobayashi is using the term backside as a adjective and not as a noun and is not indicating any additional surface of the head body. There is no mention in the claims or disclosure of a top surface. The description of the drawings and description of the preferred embodiment fail to make any further clarification. It therefore appears that Kobayashi has a face surface and a bottom surface with the result being an

intersection of the bottom surface at the top of the face surface and an intersection of the bottom surface at the bottom of the face surface. The bottom in Kobayashi's head body forms a nearly continuous convex surface.

The present invention further requires that the clubhead with shaft be positioned at the angle of intended use or position of intended use to determine the location of the lines on the top surface. Ryan does not mention or refer to an angle of intended use or position of intended use, nor do Jessen or Kobayashi.

The Examiner has not referenced any art that claims a golf club with markings on the golf club top surface such as claimed by the Applicants invention.

Even if you take Jessen's bisected face guide line as it continues on the golf club head top surface, Kobayashi's weight and apply same to Ryan the result is not the Parallax Corrected Sweet Spot Target Line as disclosed or claimed in the present invention.

No new matter is included.

Reconsideration of your Office Action is requested. All of the foregoing has been accomplished to overcome the Examiner's objections. No new matter is included. It is believed that the application is now in proper form for the issuance of a Notice of Allowability and such favorable action is requested. Inventor requests the right to submit Corrections making the drawings formal within the time period set upon issuance of the Notice of Allowability.

Dated: June 14, 2005.

BERNARD J. PATSKY



By JAMES F. BAIRD  
Reg. No. 31,463